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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 93,354-SS)

PATENT

In application of:

Roninson *et al.*

Serial No. 10/010,167

Filed: December 4, 2001

For: Genes and Genetic Elements Associated
With Sensitivity to Chemotherapeutic
Drugs

Before the Examiner:
J. Ketter

Group Art Unit: 1636

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OFFICE OF PETITIONS

PETITION TO INCLUDE INADVERTENTLY OMITTED DRAWINGS

Commissioner of Patents
Washington, D.C. 20231

Sir:

Responsive to the Notice to File Corrected Application Papers, mailed January 22, 2002, Applicants hereby respectfully petition the U.S. Patent and Trademark Office to insert inadvertently omitted Figures 1K and 1L into the above-identified divisional application as filed. These Figures were filed in the parent application, U.S. Serial No. 09/568,315, now U.S. Patent No. 6,326,488, and in the priority applications from which this and the parent application make a priority claim (as evidenced by the Official Filing Receipt, Exhibit A).

Applicants filed the instant divisional application with a Preliminary Amendment that explicitly recited the chain of priority claims to which this application is entitled (Exhibit B). Applicants also filed this application with a copy of the Declaration and Power of Attorney from U.S. Serial No. 08/033,086, now abandoned, the earliest application in the priority chain having an specification identical to the specification of the instant application (Exhibit C). Applicants' Transmittal Letter (Exhibit D) accompanying the instant application contained the following statement:

Incorporation by Reference: The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied under Box 4b, is considered as being a part of the disclosure of the accompanying application and is hereby incorporated by reference herein.

The Notice to File Corrected Application Papers indicates that Applicants have three options: first, to file a petition asserting that the missing drawings were submitted with the application as filed and have been lost by the Patent and Trademark Office; second, to submit the missing drawings and accept a corrected application filing date that is the date of submission of the drawings; or third, maintain the application on file without the missing drawings and deleting all reference to the drawings in the specification by amendment.

The Notice pointedly leaves out a fourth option: submit the missing drawings as having been incorporated by reference from the parent application. This option is clearly set forth in M.P.E.P. Section 201.06(c):

INCORPORATION BY REFERENCE

In a continuation or divisional application, the safeguard (petition and fee under former 37 CFR 1.60(b)) concerning the filing of an application lacking all of the pages of the specification *or sheets of drawings* of the prior application has not been retained in 37 CFR 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a "true copy" of the prior application. As a safeguard, however, an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated by reference." The statement may appear in the specification *or in the application transmittal letter*. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been *inadvertently omitted* from the submitted application papers in the continuation or divisional application. *The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference. (Emphasis added.)*

Applicants respectfully submit that the rules of practice clearly indicate that Figures 1K and 1L of the instant application should be entered into the instant divisional application. Applicants therefore petition the Patent and Trademark Office to insert the missing drawings, submitted herewith, and advance the application to examination.

A petition fee in the appropriate amount is enclosed herewith. However, Applicants respectfully submit that this petition was unnecessary upon the proper application of the rules, and that any such fee should be refunded.

Applicants pray that their petition is granted. If the Examiner in charge of this application believes it to be helpful, he or she is invited to contact the undersigned attorney by telephone at (312) 913-0001.

Respectfully submitted,
McDonnell Boehnen Hulbert & Berghoff

By: 

Kevin E. Noonan, Ph.D.
Reg. No. 35,303

Date: March 22, 2002